IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Contopanagos, et al.
U.S. Application No.: 10/074,293
Filed: February 12, 2002

Group Art Unit: 2826
Examiner: Greene, Pershelle L.
Attorney Docket No.: BP 2108

Title: On-Chip Inductor Having Improved Quality Factor and Method of Manufacture Thereof

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

In response to the Office Action dated August 13, 2002, in U.S. Patent Application No. 10/074,293, wherein a Restriction Requirement was imposed against the following claim groups:

I. Claims 1-15, drawn to an on-chip inductor, classified in class 257, subclass 531; and

II. Claims 16-30, drawn to a method for manufacturing an on-chip inductor, classified in class 438, subclass 15+,

Applicants provisionally elect Group I with traverse. The traversal of the restriction requirement is based on the fact that the subject matter of the respective claim groups is sufficiently related to merit their continued prosecution. Furthermore, the on-chip inductor of claim Groups I and II are not independent and distinct from the method for manufacturing an on-chip inductor claims of Group II.

Applicants' reasons for the traversal of the restriction requirement are set out below, and on such basis, Applicants request the Examiner to reconsider his restriction of the pending claims, and to withdraw same in favor of consolidated examination and prosecution of claims 1-30.

An Examiner's authority to require restriction is defined and limited by statute:

"If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. 35 U.S.C. § 121, first sentence (emphasis added)."

The implementing regulations of the Patent and Trademark Office include the mandate that restriction is appropriate only in cases presenting inventions, which are both independent **and** distinct, 37 C.F.R. §§1.141-142. Without independence and distinctness, a restriction requirement is unauthorized.

In the present application, the inventions which the Examiner has grouped separately are not "independent and distinct" so as to justify the restriction requirement. The claims 1-15 are directed to an on-chip inductor, while claims 16-30 are directed to a method for manufacturing the on-chip inductor of claims 1-15. Accordingly, claim Groups I and II cannot be considered "independent" of one another, and are clearly interrelated and interdependent, not "independent and distinct."

The interdependence of the claim groups is confirmed --indeed it is mandated-- by virtue of the fact that the description requirements of 35 U.S.C. §112 compel disclosure of both aspects of the invention in the one application, which applicants have filed.

In addition, the courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein. The CCPA has observed:

> We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved. In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications, which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold

that §121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990) that court held that §121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of patent on the divisional application.

For the above reasons, applicants respectfully request that the Examiner withdraw the restriction requirement and examine all of the aspects of the present invention as the unitary invention that it is.

The Examiner is invited to contact the undersigned by telephone or facsimile if the Examiner believes that such a communication would advance the prosecution of the present invention.

Respectfully submitted.

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

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ENCLOSURES *(check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☑ Amendment / Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
  - ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Assignment Papers *(for an Application)*
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
- ☐ After Allowance Communication to Group
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to Group *(Appeal Notice, Brief, Reply Brief)*
- ☐ Proprietary Information
- ☐ Status Letter
- ☐ Other Enclosure(s) *(please identify below)*

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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Signature	
Date	09/13/2002

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: 09/13/2002

Typed or printed name	Armando Pastrana, Jr.		
Signature		Date	09/13/2002